

Application No. 10649,459
Response to 12 June 2006 Non-Final Office Action

REMARKS

1. Claims 1-15 are pending. No claims are amended, added or canceled by this response to the Office Action.
2. For reasons stated hereinbelow, reconsideration and withdrawal of the rejections are respectfully requested.

35 U.S.C. § 103

3. Claims 1-4, and 7-15 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. 6,271,745 ("Anzai et al."). Applicant respectfully traverses this rejection.

In order to establish a prima facie case of obviousness, a rejection must cite documents which teach or suggest all the claim limitations,¹ establish a proper motivation for modifying the documents cited against the claims,² and show a reasonable expectation of success.³

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.⁴

¹ See M.P.E.P. 2143 ("To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.").

² See, M.P.E.P. § 2142 ("To establish a prima facie case of obviousness, ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination ... must ... be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).").

³ See MPEP § 2143 ("To establish a prima facie case of obviousness, ... there must be a reasonable expectation of success. The ... reasonable expectation of success must ... be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).").

⁴ See M.P.E.P. § 2143.03 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).").

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The motivation to modify the documents cited against the claims must be present in the documents themselves or otherwise in the prior art, not in the instant application^{5,6} and must be "clear and particular."⁷ If the proposed modification renders the prior art unsatisfactory for its intended purpose there is no motivation for the proposed modification.⁸ That the disclosures of the documents cited against the claims can be modified or that the asserted modification is within the ability of a person of ordinary skill in the art is not sufficient to establish the required

⁵ See M.P.E.P. § 2142 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.").

⁶ Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985) ("Regarding an invention directed to a combination of known elements, the Board indicated that the examiner had done little more than cite references showing that elements or subcombinations of them were known. To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.").

⁷ See In re Dembicza, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[The] district court's conclusion of obviousness was error when it 'did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination.' [citations omitted] ... The range of sources available, however, does not diminish the requirement for actual evidence. That is the showing must be clear and particular.") (emphasis added).

⁸ See M.P.E.P. § 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*,

733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

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motivation.^{9,10, 11, 12} Logic and sound reasoning in the absence of a motivation are also insufficient to establish a prima facie case of obviousness.¹³ Moreover, neither conclusory statements within the rejection nor subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.¹⁴

⁹ See M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.").

¹⁰ See M.P.E.P. 2143.01 ("A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Int. 1993). See also, In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references..)" (emphasis added)).

¹¹ In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.").

¹² In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (The Federal Circuit accepted that in this case the level of ordinary skill was very high, but "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.").

¹³ Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Int. 1993) ("That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.").

¹⁴ See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed Cir. 2002) ("The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in

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Additionally, that all the pending claim limitations are known does not make the claim obvious in the absence of the requisite motivation.¹⁵ Moreover, neither conclusory statements within the rejection nor subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.¹⁶ Indeed, if the rejection asserts that the motivation was generally present in the art at the time of the invention, the Examiner may be required to execute an affidavit or declaration to that effect so that the Applicant may have the opportunity to explain or dispute the assertions therein.^{17,18} Additionally, evidence of

determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.") (internal quotation marks omitted) (emphasis added).

¹⁵ See, Abbott Laboratories v. Syntron Bioresearch Inc., 67 USQP2d 1337, 1347 (Fed. Cir. 2003) ("Syntron cites a statement by an expert for Abbott that the use of the fluid sample to drive the flow was known in the prior art. [Citation omitted.] Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render the claim obvious. Graham v. John Deere Co., 383 U.S. 1, 17-18 [149 USPQ2d 459] (1966); Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1328, 63 USPQ2d 1374, 1383 (Fed. Cir. 2002). The issue is whether substantial evidence supports the judgment ... that a person having ordinary skill in the art would not have been motivated to replace the developing fluid/sample solution combination of Deutsch with flow provided solely by sample fluid.").

¹⁶ See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed Cir. 2002) ("The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.") (internal quotation marks omitted) (emphasis added).

¹⁷ See M.P.E.P. § 2144.03 ("As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 59 USPQ2d 1693, 1697.... If the examiner is relying on personal knowledge to support the finding of what is

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patentability is established if the disclosures of the cited documents actually teach away from the asserted modification.¹⁹

At least some degree of predictability is required to support a prima facie case of obviousness and evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.²⁰

Only analogous prior art can be cited against claims in an obviousness rejection.²¹ In determining whether prior art is analogous, the "reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."²² However, the solution to the problem to be solved cannot be

known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) ("When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons'").") (emphasis added).

¹⁸ See, In re Thrift, 63 USPQ2d 2002, 2006-2007 (Fed. Cir. 2002) ("Recently in In re Lee [Citation omitted.], we held that the Board's reliance on 'common knowledge and common sense' did not fulfill the agency's obligation to cite references to support its conclusions. [Citation omitted.] Instead, the Board must document its reasoning on the record to allow accountability. [Citation omitted.]").

¹⁹ See MPEP § 2155.05 III ("A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)").

²⁰ M.P.E.P. 2143.02 citing "In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

²¹ MPEP 2141.01(a) ("TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

²² MPEP 2141.01(a) ("The examiner must determine what is 'analogous prior art' for the purpose of analyzing the obviousness of the subject matter at issue. 'In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.' In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ('A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would

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considered when determining analogy.²³ Moreover, whether or not prior art is, in fact, analogous, the required motivation to modify the disclosure of one document with another must nonetheless be present.²⁴

In relevant part and after admitting that Anzai et al. fails to disclose or suggest the use of an electronic key, the rejection states:

the use of electronic keys in controlling vehicle operations is old and well known in the art and would have been obvious to one of ordinary skill in the art at the time of the invention to use [an] electronic key in place of the described cart of Anzai in order to increase reliability and/or security if it is held the teachings of Anzai do not teach such an electronic device [sic].... while the communication interface of Anzai is performed with wires it is well-known that wireless communication may be substituted in place of hardwired communication as an alternative means to transmit information in cases where the transmitter and receiver may be far apart.

have commended itself to an inventor's attention in considering his problem."); Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and State Contracting & Eng'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved.").

²³ See Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) ("The district court's formulation of the problem confronting the '053 inventors presumes the solution to the problem — modification of the stem segment. Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. [citation omitted] By importing the ultimate solution into the problem facing the inventor, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content of the prior art.") (emphasis added).

²⁴ See Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 USPQ2d 1977, 1982 (Fed. Cir. 1998) ("By defining the inventor's problem in terms of its solution, the district court missed this necessary antecedent question, namely whether the prior art contains a suggestion or motivation to combine references to form a trend [emphasis in original].... It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the references in the right way so as to achieve [a desired result]. Stated otherwise, what would have impelled one of ordinary skill to recognize a relationship between stem segment height and the hook breakage problem? If those of ordinary skill would have recognized a relationship, then, and only then, does the trial court proceed to examine whether the prior art in fact contains a coherent teaching about that relationship.") (emphasis added except where indicated).

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Applicant respectfully submits that if wireless communication is "well-known" as asserted in the rejection, a reference disclosing this limitation should be easily found and combined with Anzai et al., if the requisite motivation to modify Anzai in this manner can be established. To this end, Applicant respectfully traverses that the wireless communication, in the context of the other limitations of independent claims 1, 8, and 12, are well-known and the Examiner is respectfully required to submit either a reference disclosing this limitation or an affidavit or declaration asserting with particularity facts showing that this limitation was well known in the art at the time of this invention. Moreover and assuming arguably that the assertion is true, the presence of the limitation in the prior art, does not, itself, establish the requisite motivation. Thus, even if the Examiner can make a showing that the limitation at issue was well-known to the art at the time of the invention, the Examiner must nonetheless show the requisite motivation to modify the disclosure of Anzai et al. as proposed in the rejection was present in the prior art. As shown above, subjective opinion stated in the rejection is not sufficient to establish the required motivation to modify the disclosure of Anzai et al. as proposed in the rejection. To this end, the Examiner is respectfully required to either provide a document disclosing the requisite motivation or to execute a declaration or affidavit stating with particularity facts establishing that the requisite motivation was indeed present in the art at the time of the invention. Because of the unsubstantiated assertion that the limitation a question was "well known" and because the unsubstantiated, subjective opinion regarding the motivation to modify the disclosure of Anzai et al. does not establish the required motivation, a prima facia case of obviousness has not been established with respect to independent claims 1, 8, and 12. The other rejected claims depend directly or indirectly from the rejected independent claims.

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Therefore, a prima facia case of obviousness has not been established with respect to the other rejected claims as well.

4. Claims 5-6 are rejected under 35 U.S.C. § 103(a) as obvious over Anzai et al., in view of U.S. 6,281,599 ("Murakami et al."). Applicant respectfully traverses this rejection.

The rejection states, in part, "the use of containing circuitry for a vehicle control functions and the key or key fob type devices as well known in the art see for example Murakami. Murakami et al. teaches the control and verification circuitry may be located in the key." The rejection then concludes, "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Anzai to put the circuitry of the restriction information generation device or the individual identification device in the key in order to increase the security of the key." Assuming arguably that the foregoing assertion is true, Applicant, for reasons stated above, respectfully points out that the rejection nonetheless fails to establish the required motivation to modify the disclosure of Anzai et al. with the disclosure of Murakami et al. in the manner suggested in the rejection. As shown above and assuming arguably that the foregoing assertion is true, the mere presence of the asserted limitation in Murakami et al. does not establish the requisite motivation to modify the disclosure of Anzai et al. with the disclosure of Murakami et al. in the manner proposed in the rejection. Stated otherwise, that a limitation is known does not, itself, establish the requisite motivation.

Because the requisite motivation to modify the disclosure of Anzai et al. with the disclosure of Murakami et al. has not been established, a prima facia case has not been shown against rejected claims 5-6. Claims 5-6 depend directly or indirectly from claim 1. Therefore and additionally, claims 5-6 are not obvious because claim 1 is not obvious as shown above.

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Conclusion

5. In view of the foregoing, it is submitted that this Application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. To this end, the Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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